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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,222	08/02/2005	Michael Smolong	48753	9493
1609 7590 10/07/2008 ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P. 1300 19TH STREET, N.W. SUITE 600 WASHINGTON,, DC 20036				
EXAMINER				
IRVIN, THOMAS W				
ART UNIT		PAPER NUMBER		
3657				
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10/07/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/544,222

**Applicant(s)**

SMOLONG ET AL.

**Examiner**

THOMAS W. IRVIN

**Art Unit**

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CD/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The finality of the office action mailed June 13, 2008 has been withdrawn and Applicant's remarks filed May 23, 2008 have been entered. A new grounds of rejection is set forth below.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (5,279,391) in view of Hauser (4,420,990).

In Re claim 11, Ward discloses a lubricating device comprising: gear stages (24,26,28,30,32,34) mounted next to one another and dynamically connected to one another; a lubricant circuit having at least one filter (48) therein, having a lubricant supply (51) for providing lubricant to said first gear stage, having a lubricant inlet (46) for removing lubricant from said second gear stage, and circulating lubricant drawn from said lubricant outlet to said filter for cleaning and then to said lubricant supply. Ward further discloses an immersion bath (40), but fails to disclose individual immersion baths for the gear stages.

Hauser teaches adding a filler (18) to the inside of a transmission casing (11) which separates the gears (A,B,C). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transmission of Ward, to include transmission filler, as taught by Hauser, to occupy most of the space in a transmission between the gears and the housing (11), thus reducing the amount of lubricant necessary to lubricate the gears. Examiner notes that doing so would create an individual immersion bath for each gear stage.

In Re claims 14 and 15, Ward further discloses a suction device, motor pump (44), an injection device, nozzle (51), mounted diagonally opposite one another in the upper and lower area of the transmission housing.

In Re claim 16, Ward further discloses that the filter unit (48) is mounted between the motor pump unit (44) and gear housing (12) in the lubricant circuit.

Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward (5,279,391) in view of Hauser (4,420,990) as applied to claim 11 above, and further in view of Sann et al. (2004/0074827).

Ward, as modified, teach the claimed invention except failing to teach the specifics of the filter unit.

Sann et al. teach, with reference to Fig. 1, a filter unit (10) having a first fine filter (12), which is safeguarded with a bypass (22), and a coarse filter (32) connected in series with the first filter. The filter fineness of the coarse filter meets the limitations of being approximately 5 to 10 times greater than the filter fineness of the fine filter. I

would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transmission, taught by Ward as modified, to include a filter unit with two filters and a bypass, as taught by Sann et al., to fully strain the lubrication oil of any contaminants.

Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. (6,607,464) in view of Ward (5,279,391) and Hauser (4,420,990).

Bauer et al. disclose a wind power station comprising: a casing (1) with an interior having a first and second gear stages (5,9) (see Fig. 7) mounted next to one another and dynamically connected to one another. Bauer et al. further disclose both planetary and spur gears. Bauer et al. fail to disclose a lubricant circuit.

Ward discloses including in a gearing unit (10), a lubricant circuit having at least one filter (48) therein, having a lubricant supply (51) for providing lubricant to a first gear stage (34), having a lubricant inlet (46) for removing lubricant from a second gear stage (24), and circulating lubricant drawn from said lubricant inlet to said filter for cleaning and then to said lubricant supply.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the wind power station to include a lubricant circuit with a filter, as taught by Ward, to provide clean lubricant to the gearing of the power station unit, thus increasing the lifespan of the unit.

Ward fails to disclose individual immersion baths for the gear stages.

Hauser teaches adding a filler (18) to the inside of a transmission casing (11) which separates the gears (A,B,C). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the power station unit of Bauer et al., as modified, to include transmission filler, as taught by Hauser, to occupy most of the space in a transmission between the gears and the housing (11), thus reducing the amount of lubricant necessary to lubricate the gears. Examiner notes that doing so would create an individual immersion bath for each gear stage.

In Re claims 14 and 15, Ward further teaches a suction device, motor pump (44), an injection device, nozzle (51), mounted diagonally opposite one another in the upper and lower area of the transmission housing.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the power station unit to include a lubricant motor pump (44), and nozzle (51) mounted diagonally opposite one another in the upper and lower area of the transmission housing to circulate and provide clean lubricant to the gearing of the power station unit, to increase the lifespan of the unit.

In Re claim 16, Ward further teaches that the filter unit (48) is mounted between the motor pump unit (44) and gear housing (12) in the lubricant circuit.

Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. (6,607,464) in view of Ward (5,279,391) and Hauser (4,420,990) as applied to claim 11 above, and further in view of Sann et al. (2004/0074827).

Bauer et al., as modified, teach the claimed invention except failing to teach the specifics of the filter unit.

Sann et al. teach, with reference to Fig. 1, a filter unit (10) having a first fine filter (12), which is safeguarded with a bypass (22), and a coarse filter (32) connected in series with the first filter. The filter fineness of the coarse filter meets the limitations of being approximately 5 to 10 times greater than the filter fineness of the fine filter.

I would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the transmission, taught by Bauer et al. as modified, to include a filter unit with two filters and a bypass, as taught by Sann et al., to fully strain the lubrication oil of any contaminants.

### ***Response to Arguments***

Applicant's arguments, see remarks, filed September 15, 2008, with respect to the rejection(s) of claim(s) 11-13 under 103(a) by Hambric (4,590,820) in view of Ward (5,279,391) and Hauser (4,420,990) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bauer et al. (6,607,464), Ward (5,279,391), and Hauser (4,420,990).

Applicant's arguments regarding the 103(a) rejection of claims 11 and 14-16 by Ward (5,279,391) and Hauser (4,420,990) have been fully considered, but they are not persuasive. The examiner points to fig. 3 of Hauser, which shows the division of gear stages A, B, and C by the filler (18). As used in the gear casing of Ward, the examiner

believes that the filler would effectively separate the space around the gear stages into separate immersion baths, as claimed.

Additionally, regarding applicant's arguments against the references individually; one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS W. IRVIN whose telephone number is (571)270-3095. The examiner can normally be reached on Mon-Fri 8am-4pm, Alt Fri off (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on (571) 272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas W. Irvin/  
Examiner, Art Unit 3683

/Robert A. Siconolfi/  
Supervisory Patent Examiner, Art  
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